

REMARKS

The Present Invention and the Pending Claims

The present invention relates to a method of producing citalopram and an intermediate therefor. Claims 17 and 21-28 are currently pending. Claim 17 is directed to a method of producing the intermediate aldehyde compound of formula [V], which intermediate aldehyde compound is useful to produce citalopram. Claims 21-28 include the step of producing the same intermediate aldehyde compound of formula [V] within the context of a series of steps to produce citalopram. Reconsideration of the pending claims is respectfully requested.

Amendments to the Abstract and Claims

The abstract has been amended to comport with the amended claims. Claims 1-7 have been canceled as directed towards nonelected subject matter. New claims 21-28 have been added and are supported by the specification of the present patent application at, for example, page 12, line 28, through page 24, line 32. Claim 22 is essentially a copy of pending claim 2 of U.S. Patent Application No. 09/794,755 (Publication No. 2002/0004606 A1) (Petersen et al. — H. Lundbeck A/S) (the '755 application). No new matter has been added by way of the abstract and claim amendments. The precise changes to the abstract and claims, as well as the text of the pending claims as amended, are set forth on separate attachments hereto.

Priority

The present application is a divisional application of co-pending U.S. Application No. 09/654,768 (the '768 application), now U.S. Patent 6,433,196, which claims priority to JP 2000-39936 (filed February 17, 2000) and JP 2000-65527 (filed March 9, 2000). The instant specification was amended to include the cross reference to related applications by way of the Preliminary Amendment filed February 28, 2002. The priority documents were filed in conjunction with the '768 application.

Summary of the Office Action

The Office Action maintains the restriction requirement, and claims 1-7 have been withdrawn from consideration. Based on the prior election of claim 17, claim 17 is rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claim 4 or 6 of U.S. Patent 6,310,222 (the '222 patent) in view of Allinger et al. ("Organic Chemistry," pp. 452-455 (1971)). In this same regard, claim 17 is rejected under 35 U.S.C. § 103(a) as obvious in view of the '222 patent in view of the Allinger et al. reference.

Discussion of the Obviousness and Obviousness-type Double Patenting Rejections

As regards the obviousness rejection, the '222 patent qualifies as prior art only under 35 U.S.C. § 102(e). Both the present patent application and the '222 patent were, at the time the invention of the present application was made, owned by, or at least subject to an obligation of assignment to, the same entity, namely Sumika Fine Chemicals Company, Ltd. Accordingly, the '222 patent cannot be cited as prior art in an obviousness rejection of the present patent application. 35 U.S.C. § 103(c). As a result, the obviousness rejection should be withdrawn.

As regards the obviousness-type double patenting rejection, a terminal disclaimer is filed herewith to remove the obviousness-type double patenting rejection.

Request for Interference

In accordance with 37 C.F.R. § 1.604, applicants request that an interference be declared between the present patent application and pending U.S. Patent Application No. 09/794,755. The proposed count of the interference would be the same as newly added claim 22 and at least that claim would correspond to the proposed count, as well as possibly other pending claims of the present patent application. Claim 2 of the '755 application, which is of the same claim scope of newly added claim 22, also would correspond to the proposed count. Applicants understand that claim 2 of the '755 application has been deemed allowable (i.e., deemed to define patentable subject matter) by the Patent Office. Accordingly, newly added claim 22 should be allowable in the present patent application. Since the present patent application and the '755 application are claiming the same patentable subject matter, an interference is appropriate between the two pending patent applications.

Information Disclosure Statement

Applicants submitted an Information Disclosure Statement on February 28, 2002, which identified references AA-AE on the accompanying PTO-1449 form. The Office Action included a copy of the PTO-1449 form with the Examiner's initials thereon; however, the citation to Reference AE (Dokunikhin et al., *Chemical Abstracts*, 60 (13) (XP-002166788) (1964)) was not initialed. Applicants respectfully request a copy of the Examiner-initialed PTO-1449 form with the Examiner's initials next to the citation to Reference AE, thereby confirming consideration of Reference AE.

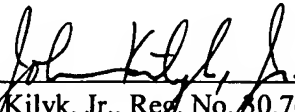
Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a

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telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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Date: September 3, 2002

CERTIFICATE OF MAILING

I hereby certify that this RESPONSE TO OFFICE ACTION AND REQUEST FOR INTERFERENCE (along with any documents referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231.

Date: September 3, 2002

